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| 09/782,754      | 02/12/2001  | David Leigh Donoho   | UNIV0001C           | 1053             |

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| EXAMINER |
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SIDDIQI, MOHAMMAD A

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| ART UNIT | PAPER NUMBER |
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2154

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DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/782,754

Applicant(s)

DONOHO ET AL.

Examiner

Mohammad A Siddiqi

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-16 are presented for examination.

#### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-5 of U.S. Patent No. 6,256,664 contains every element of claims 1-16 of the instant application and as such anticipates claims 1-16 of the instant application.

4. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferguson et al. (5,649,186) (hereinafter Ferguson).

7. As per claims 1 and 8, Ferguson discloses a communications system (col 1, lines 6-10), comprising:

an advice provider which broadcasts information over a communications medium (col 3, lines 39-60, news feed);

an advice consumer for gathering said broadcast information from said communications medium (col 4 lines 61-63 and col 15-45); and

a reader associated with said advice consumer for determining relevance of said broadcast information (col 4 lines 60-65 and col 5, 1-25);

wherein said advice consumer is advised of said information only if said information meets certain predetermined relevance criteria (fig 5,col 5, lines 1-14 and col 5, lines 15-45).

8. As per claim 2, Ferguson discloses wherein said reader further comprises: means for providing relevant information to said advice consumer without revealing any aspect of said advice consumer's identity to said advice provider (col 3, lines 39-67 and col 6, lines 61-65 and col 7, lines 1-5).

9. As per claim 3, Ferguson discloses wherein relevance of said information to said advice consumer is based upon any of the properties of an advice consumer's computer, said computer's contents or state, or the properties of a local environment associated with said computer (col 5, lines 1-46).

10. As per claim 4, Ferguson discloses wherein said advice consumer maintains anonymity, privacy, and security by not revealing to said advice provider either that said advice consumer is provider, that said advice consumer has received any particular message, or that said information is relevant to said advice consumer (col 5, lines 1-46 col 6, lines 35-61).

11. As per claim 5, Ferguson discloses wherein said information being broadcast may consist of any of humanly interpretable content, data, or software tools (col 3, lines 39-60).

12. As per claim 6, Ferguson discloses wherein said advice provider specifies an audience for whom said information is potentially relevant by referring to properties of an advice consumer which are used to determine the relevance of said information to said advice consumer (col 3, lines 39-67 and col 4, lines 60-67).

13. As per claim 7, Ferguson discloses communications method, comprising the steps of:

preparing a message at an advice provider location (col 1, lines 53-55, template);

broadcasting said message to potential advice consumers anonymously using a network (col 1, lines 53-67, and col 3, lines 39-60);

processing said message at an advice consumer location (col 1, lines 53-67, and col 3, lines 39-60);

determining whether said message is relevant to said advice consumer (col 1, lines 53-67, and col 3, lines 39-60);

wherein said message is broadcast to advice consumers to whom it is relevant without requiring that said advice consumers divulge their identity or attributes to said advice provider (fig 5,col 5, lines 1-14 and col 5, lines 15-45).

14. As per claim 9, Ferguson discloses further comprising: an advice reader associated with an advice consumer computer for performing relevance determination (col 4, lines 60-65 and col 5, 1-25).

15. As per claim 10, Ferguson discloses wherein relevance determination is automatically performed based on a combination of conditions, including any of hardware attributes, configuration attributes, database attributes, environmental attributes, computed attributes, remote attributes, timeliness, personal attributes, randomization, and advice attributes (fig 3, col 5, lines 1-14 and col 5, line 46-67, and col 6, lines 1-35).

16. As per claim 11, Ferguson discloses wherein said advice reader operates automatically to determine relevance (col 3, lines 39-67 and col 4, lines 6-60).

17. As per claim 12, Ferguson discloses said advice reader comprising:

a gatherer for gathering advisories to which said advice consumer subscribes (col 1, lines 50-67);

a subscription manager for entering subscriptions to advisories based on information in at least one advice consumer site definition file (col 2, lines 50-67);

an unwrapper for parsing said advisories (col 1, lines 50-67);

a module for determining the relevance of said advisories, said determination being made either continuously, at scheduled intervals, or under user manual control (col3, lines 10-67, dynamically processing include time);

a user interface that receives relevant advisories (fig 5); and

a display and management system that displays relevant advisories for inspection by said advice consumer (fig 5).

18. As per claim 13, Ferguson discloses wherein any information that is actually on an advice consumer computer or reachable from said advice consumer computer may be used to determine relevance (col 3, lines 39-67 and col 6, lines 60 -67, and col 7, lines 1-10).

19. As per claim 14, Ferguson discloses wherein said advisories comprise:

digital documents which contain an explanatory component describing in terms said advice consumer can easily understand the reason that said advisory is relevant and the purpose and effects of the action which is being recommended to said advice consumer (col 1, lines 50-67 and col 3, lines 39-67)).

20. As per claims 15-16, claims 15-16 have similar limitations as claims 8-14. Therefore they are rejected under Ferguson for the same reasons set forth in the rejection of claims 8-14.

### ***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent 5,388,188 to Selfridge et al.

U.S. Patent 5,923,845 to Kamiya et al.

U.S. Patent 6,047,053 to Miner et al.

U.S. Patent 5,796,395 to De Hond et al.

U.S. Patent 6,078,924 to Ainsbury et al.

U.S. Patent 6,604,130 to Donoho et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A Siddiqi whose telephone number is (703) 305-0353. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MAS



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